

Attorney Docket No. P P67431US0
Application No. 09/926,820

Remarks/Arguments:

Previously presented claims 15 and 18-20, with claims 18-20 amended hereby, are pending.

Claims 16, 17, and 21-28 are cancelled hereby, without prejudice or disclaimer.

The specification is amended, hereby, by inserting the heading "Brief Summary of the Invention" at an appropriate place in the text.

The amendments to present claims 18, 19 and 20, effected hereby, address issues raised in the Office Action, as explained below, and otherwise more clearly define the invention.

Claims 16, 17, and 21-28 were withdrawn from consideration as being directed to non-elected subject matter, pursuant to a requirement for restriction. Accordingly, the withdrawn claims are cancelled hereby, without prejudice or disclaimer.

The Office Action includes an objection to the specification, apparently because the originally filed specification does not include the *headings* recommended in the PTO Rules. An objection to the specification cannot be sustained based solely on the specification failing to include any of these *recommended* headings. As set forth in the PTO Rules, themselves, the headings should be included only *if applicable*. In accordance with 37 CFR 1.77(c) (*emphasis added*):

The text of the specification sections defined in paragraphs (b)(1) through (b)(11) of this section, *if applicable, should be preceded by a section heading* in uppercase and without underlining or bold type.

In making the use of section headings in a specification *optional* (i.e., for use "if applicable"), the PTO Rules take into account that the specification text does not always lend itself to partitioning in two sections, each of which exclusively contains specifically defined information. Since the PTO

Attorney Docket No. P P67431US0
Application No. 09/926,820

Rules make use of section headings merely *optional* – failure to satisfy PTO Rules not being shown by the absence of section headings – the objection to the specification appears to be in order for withdrawal.

Notwithstanding the foregoing, and in a good faith effort to advance prosecution, the specification is amended, hereby, to include the heading "Brief Summary of the Invention." The section heading is inserted into the specification immediately preceding the corresponding specification text.

The objections to claims 18 and 19 are rendered moot by the instant amendment. As amended hereby, claims 18 and 19 do not contain any non-elected subject matter.

Claim 20 was rejected under 35 USC 112, second paragraph, for allegedly being indefinite, and under 35 USC 101, for allegedly being a non-statutory *use* claim. Reconsideration is requested in view of the changes to the rejected claim, effected hereby.

In accordance with the §112, ¶2, statement of rejection, claim 20 is allegedly indefinite for reciting (*emphasis added*) "the prophylaxis of lung emphysema formation *in* deficiencies of α_1 -proteinase inhibitor." The statement of rejection alleges that use of the word "in" renders the stated use "impossible" (Office Action, page 8). The allegation appears somewhat questionable.

Nonetheless, in order to overcome the rejection, claim 20 as amended, hereby, recites "because of" in place of "in," as suggested by the Examiner. Applicants wish to thank the examiner for kindly suggesting alternative claim language for overcoming the rejection.

Attorney Docket No. P P67431US0
Application No. 09/926,820

According to the statement of rejection, claim 20 is allegedly indefinite, further, "since the claim does not set forth any steps involved in the [recited] treatment process" (Office Action, page 8). This basis for the rejection no longer applies, since claim 20 as amended, hereby, expressly recites the *step* of "administering the serine protease inhibitor to a patient in need thereof."

For the foregoing reasons, in that the bases on which the rejection relies are no longer applicable, the rejection under §112, ¶2, of claim 20 is overcome. Accordingly, withdrawal of the rejection appears to be in order.

With respect to the rejection of claim 20 under §101, it is rendered moot by the instant amendment. First of all, claim 20 is amended, hereby, to recite (*emphasis added*) a "*method of using* the serine protease inhibitor according to claim 15." Secondly, claim 20 is amended, hereby, to recite the active method step "administering the serine protease inhibitor to a patient in need thereof," as indicated above.

For the foregoing reasons, the rejection of claim 20 under §101 is rendered moot by the instant amendment. Accordingly, withdrawal of the rejection appears to be in order.

Claim 15, as originally presented, "is allowed" (Office Action, page 8). Claims 18 and 19, as originally presented, were found "allowable," according to the Office Action, "if rewritten to remove the non-elected subject matter" (Office Action, page 8). Applicants wish to thank the examiner for timely notice of allowed, and allowable, claims.

Attorney Docket No. P P67431US0
Application No. 09/926,820

Claims 18 and 19 are, now (i.e., as amended hereby), allowable in accordance with the Office Action. By the instant amendment, claims 18 and 19 are "rewritten to remove the non-elected subject matter" and are, therefore, "allowable."

Claim 20 as amended, hereby, is allowable, as explained above. In view of the amendments to claim 20, effected hereby, the rejections of claim 20 under §112, ¶2, and §101 are overcome.

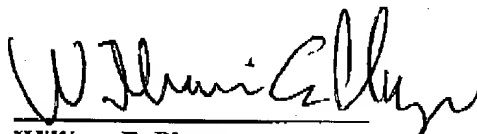
Claims 15, 18, 19, and 20 are the only active claims. Since these claims are, either, allowed or allowable, as explained above, the subject application is in immediate form for allowance.

Favorable action is requested.

Respectfully submitted,

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